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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,093	07/16/2003	Juergen Roeders	35802	9269
116	7590	07/22/2005	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			FOOTLAND, LENARD A	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 07/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/621,093	ROEDERS, JUERGEN
	Examiner Lenard A. Footland	Art Unit 3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 May 2005.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10 and 12-30 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 29 is/are allowed.

6) Claim(s) 1-5,8-10,12-18,28 and 30 is/are rejected.

7) Claim(s) 6-7, 19-27 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \*    c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1, 3, 5, 12-13, 28 are rejected under 35 U.S.C. § 102(b), as being anticipated by British '818. The examiner finds all claimed subject matter to be present.

See p. 1, lines 15, 24, and lines 40-51. Restoring clearances to their original value is the same as damping vibration.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4, 8-10, 17-18, 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over British '818 in view of Ochai et al.

The examiner finds that except for those shown by Ochai et al., British '818 discloses all of the claimed elements and functions, including, for example, load response and constant clearance.

The examiner finds that the Ochai et al. reference expressly discloses what British '818 does not, the conventionality of monitoring pressure and responding via flow rate (col. 4, line 15-16, and abstract) to maintain constant gap. Applying the test for obviousness set forth in *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981), which is what the combined teaching of the references would have suggested to those of ordinary skill in the art, the examiner finds that one having ordinary skill in the art would have found that providing the British '818 bearing with monitoring pressure and responding via flow rate taught by Ochai et al. would have been obvious in view of the teaching of Ochai et al. of doing so to maintain constant gap. Multiple and single controls of multiple pockets and variables is an obvious matter of official notice.

Claims 14-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over British '818 as in view of Lang et al.

The examiner finds that except for those shown by Lang et al., British '818 discloses all of the claimed elements and functions, including, for example, load response and constant clearance.

The examiner finds that the Lang et al. reference expressly discloses what British '818 does not, the conventionality of monitoring gap and responding via piezoelectric/piston cylinder

pocket volume (and abstract) to maintain constant gap. Applying the test for obviousness set forth in *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981), which is what the combined teaching of the references would have suggested to those of ordinary skill in the art, the examiner finds that one having ordinary skill in the art would have found that providing the British '818 bearing with monitoring gap and responding via piezoelectric/piston cylinder pocket volume would have been obvious in view of the teaching of Lang et al. of doing so to maintain constant gap. Multiple and single controls of multiple pockets and variables is an obvious matter of official notice.

Claim(s) 6-7, 19-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 29 is allowed.

Applicant's arguments have been fully considered but they are not deemed to be persuasive.

Appellant appears to have misrepresented in the interview the allowable status of previous claim 28, since parent original claim 1 of claim 7 had been amended. The analysis of the original claims in the first action was of course superseded by the following nonfinal action and was no longer operative. That is the obvious reason the

second action was nonfinal. Any inconvenience caused the applicant is regretted.

In response to Applicant's arguments, 37 CFR § 1.111(c) requires applicant to "clearly point out the patentable novelty which he thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He must also show how the amendments avoid such references or objections." In this case, applicant has failed to clearly point out patentable novelty and failed to show how the amendment avoids the combination of references applied against the claim.

Applicant had no objection to the secondary rejections beyond the unpersuasive objection to the primary reference. Clearly, a process that damps all movement will damp the subcategory of oscillatory movement.

In response to Applicant's arguments, 37 CFR § 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the references.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lenard A. Footland, whose telephone number is (571) 272-7103.



Lenard A. Footland  
Primary Examiner

Technology Center 3600

Art Unit 3682

laf  
July 17, 2005